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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,339	06/21/2001	William Y. Conwell	P0379	7232
23735	7590	05/04/2005	EXAMINER	
DIGIMARC CORPORATION 9405 SW GEMINI DRIVE BEAVERTON, OR 97008			SONG, HOSUK	
			ART UNIT	PAPER NUMBER
			2135	
DATE MAILED: 05/04/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/888,339

Applicant(s)

CONWELL ET AL.

Examiner

Hosuk Song

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 11,16-18 and 22 is/are allowed.
- 6) ☒ Claim(s) 1-10,12-15 and 19-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 09888339.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-4,6,9,19,12,20 are rejected under 35 U.S.C. 102(e) as being anticipated by Jain et al.(US 6,185,318) or Aucsmith(US 6,148,407).

Claim 1: Jain disclose aggregating first fingerprint data and second fingerprint data wherein the first fingerprint data originated at a first source and second fingerprint data originated at second source, and the first source and the second source are remotely located in (fig.5). Aucsmith disclose in (col.7,lines 15-19). Jain discloses identifying information associated with the first fingerprint data and the second fingerprint data and determining a subset of the associated information in (col.8,lines 63-67;col.9,lines 1-7 and fig.5). Aucsmith disclose in (col.7,lines 20-23;col.8,lines 58-65).

Claims 3,4: Jain disclose determining is based at least in part on a frequency occurrence of the subset and subset comprises at least one of audio, video, and image data in (fig.5). Aucsmith disclose in (col.3,lines 52-58).

Claim 6: Aucsmith disclose first set of audio fingerprint and second set of audio fingerprints in (col.3,lines 42-44,52-57).

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Claim 9: Jain discloses receiving a signal from a first broadcast at a reference receiver;generating first fingerprint data from the received signal in (fig.5). Aucsmith disclose in (col.3,lines 52-58). Jain disclose applying the first fingerprint data to a database to select associated information and receiving second fingerprint data and comparing the second fingerprint data with the associated information in (fig.5 and col.8,lines 63-67;col.9,lines 1-7). Aucsmith disclose in (col.8,lines 58-65).

Claim 19: Jain discloses querying a second database to determine additional information in (fig.5).

Claim 12: Jain discloses receiving a signal from a first broadcast source at reference receiver,generating first fingerprint data from the received signal in (fig.5). Aucsmith disclose in (col.3,lines 52-58). Jain disclose applying the first fingerprint data to a database to select associated information and receiving second fingerprint data and comparing the second fingerprint data with the associated information wherein a user device generates second fingerprint data in (fig.5 and col.8,lines 63-67;col.9,lines 1-7). Aucsmith disclose in (col.8,lines 58-65).

Claim 20: Jain discloses receiving a signal from a first broadcast source at a reference receiver, the signal comprising an embedded digital watermark in (fig.5 and col.6,lines 64-67;col.7,lines 1-3).Aucsmith in (fig.1). Jain discloses decoding the digital watermark to obtain a plural-bit identifier; interrogating a database with the identifier to identify a set of fingerprints associated with the received signal in (col.9,lines 35-45). Aucsmith in (fig.3,4). Jain discloses receiving second fingerprint data and comparing the second fingerprint data with the set of fingerprints in (fig.5). Aucsmith in (fig.4).

***Claim Rejections - 35 USC § 103***

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2,5,10,21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jain et al.(US 6,185,318) or Aucsmith (US 6,148,407).

Claims 2,10,21: Official notice is taken that vote tally is well known in the art. One of ordinary skill in the art would have been motivated to use vote tally in order to enhance the data analysis and distribution scheme.

Claim 5: Neither Jain nor Aucsmith disclose aggregating fingerprint data within a predetermined time period. It would have been obvious to person of ordinary skill in the art to modify the invention of Jain or Aucsmith to aggregate fingerprint data within a predetermined time period in order to minimize time frame for hacker from accessing the data thus creating secure environment for user to conduct transaction.

3. Claims 7,8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aucsmith (US 6,148,407) in view of DeMartin et al.(US 6,226,672).

Claims 7,8: Aucsmith disclose aggregating a first set of audio fingerprints provided by a first device with a set of audio fingerprints provided by a remotely located second device in (col.3,lines 42-44,52-58;col.7,lines 15-19). Aucsmith does not specifically disclose selecting a song from the plurality of songs based on a number of times a selected song matches the aggregated fingerprints. DeMartin discloses this limitation in (col.4,lines 49-62). It would have been obvious to person of ordinary skill in the art at the time invention was made to select a song from the plurality of songs based on a number of times a selected song matches the aggregated fingerprints as taught in

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DeMartin with fingerprint system of Aucsmith in order to match most accurate audio files from the database.

4. Claims 13-15 rejected under 35 U.S.C. 103(a) as being unpatentable over Jain et al.(US 6,185,318) or Aucsmith (US 6,148,407) in view of Li et al.(US 6,219,793).

Claims 13,14: Jain discloses receiving a signal from a first broadcast source at reference receiver,generating first fingerprint data from the received signal in (fig.5). Aucsmith disclose in (col.3,lines 52-58). Jain discloses applying the first fingerprint data to a database to select associated information in (fig.5 and col.8,lines 63-67). Aucsmith disclose in (col.8,lines 58-65). Neither Jain nor Aucsmith discloses cell phone generates the second fingerprint data. Li disclose this limitation in (fig.1). It would have been obvious to person of ordinary skill in the art at the time invention was made to employ cell phone to generate the fingerprint as taught in Li with fingerprint system of Jain and Aucsmith in order for user to conveniently process the fingerprint at any location without bound to a fixed location thus offering convenience, portability and flexibility for user to conduct data processing.

Claim 15: Jain disclose geographical location of the user device is determined by at least one of area code,cell site,device identifier, repeater identifier, and alpha-numeric data in (col.4,lines 1-18).

***Allowable Subject Matter***

5. Claims 11,16-18,22 are allowed.

Claim 11: Prior art of record does not teach comparing the second fingerprint data with the associated information wherein comparing comprises selecting a subset from the associated information based on a vote tally wherein the vote tally includes

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probabilities of a match with the second fingerprint data and selected subset has a highest probability of a match.

Claim 16: Prior art of record does not teach generating third fingerprint data from the received signal of the second broadcast source and applying the third fingerprint data to the database to selected associated information.

Claim 22: Prior art of record does not teach determining a plurality of audio and video content relating to the cumulated sets and selecting a set of audio or video content from the plurality of audio or video content based on a number of times a selected set of audio and video content corresponds with the cumulated sets.

Claims 17-18 are allowed because of dependency.

6. Claims 11,16-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Amendment***

7. Claims 1-22 are pending. The previous grounds of rejection based on the Ellis and Rump patents are withdrawn in view of Applicant's arguments in the Amendment filed 12/6/2004. However, newly discovered prior art has necessitated new grounds of rejection. The new grounds of rejection are presented above.

#### ***USPTO Contact Information***

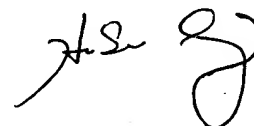
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hosuk Song whose telephone number is 571-272-3857. The examiner can normally be reached on Tue-Fri from 6:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HS

A handwritten signature in black ink, appearing to be 'HS' followed by a stylized flourish.